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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,191	09/01/1999	MARK G. DREYER	27600/M195A	3487

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EXAMINER
PAULA, CESAR B

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/388,191	DREYER ET AL.
		Examiner	Art Unit	
		CESAR B. PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 January 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-26</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the remarks filed on 1/23/2006.

   This action is made Final.

2.   In the amendment, claims 1-26 are pending in the case. Claims 1, and 16 are independent

claims.

Drawings

3.   This application has been filed with informal drawings which are acceptable for

examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-9, 11-22, and 24-26 remain rejected under 35 U.S.C. 103(a) as being

unpatentable over Simpson, A., hereinafter Simpson, Sybex, 1993, pp.539-579, 852-859, in view

of Hohensee et al, hereinafter Hohensee, (USPat.# 6,407,821 B1, 6/18/2002, filed on 9/8/1998).

Regarding independent claim 1, Simpson discloses using Wordperfect for the conversion

of an ASCII comma-delimited text (csv) file—*first page description file*-- (fig.25.3) into a

Wordperfect formatted secondary merge file, which contains part of the data in the csv file plus

additional formatting data (fig.25.4). The secondary merge file—*first page description file*--

contains records and fields to be inserted or merged into a primary merge file to produce a third

document —*second page description file* (pages 855, 540, lines 1-30).

Moreover, Simpson teaches using Wordperfect for the creation of a primary merge file—

template-- having commands telling Wordperfect exactly where to place variable text (page

553).

In addition, Simpson discloses using Wordperfect for the conversion of the csv file—*first

page description file*-- (fig.25.3) into a Wordperfect formatted secondary merge file—*database

for storing the data indicative of the portions of the first page description file*--, which contains

part of the data in the csv file plus additional formatting data—*extraction of data from the first

page description file* (fig.25.4, page 855).

Furthermore, Simpson teaches the merging of the primary merge file—*template*—and the

Wordperfect formatted secondary merge file—*database*-- to produce a third document —*second

page description file* (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4). Simpson fails to

explicitly disclose: *Wherein the first page description file includes at least layout information for

at least one page.* However, Hohensee discloses extracting the body of a pdf file and placing it

in a database (col.10, lines 21-30). It would have been obvious to a person of ordinary skill in the

art at the time of the invention to have extracted text data of name, address, etc., records from a

pdf file, store the records in a database as ascii text by combining Simpson, and Hohensee, because Hohensee teaches the benefit of avoiding redundant downloading of resources (col.3, lines 1-15). This would allow a user to effectively, and efficiently utilize data records found in pdf documents using the functionality of a wordprocessing program, such as Wordperfect.

Regarding claim 2, which depends on claim 1, Simpson discloses generating a primary merge file—*template*—with commands or placeholders for indicating location where variable information is to be placed (page 540, lines 7-30, fig. 16.1).

Regarding claim 3, which depends on claim 2, Simpson discloses an Wordperfect –*page make-up application program*-- for generating the primary merge file—*template*—with commands or placeholders for indicating location in the primary merge file where variable information is to be placed (pages 539, 540, lines 7-30, fig. 16.1).

Regarding claim 4, which depends on claim 1, Simpson teaches the merging of the primary merge file—*template*—and the Wordperfect formatted secondary merge file—*database*—(extracted from the csv file), to produce a third document —*second page description file* (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4). Simpson fails to explicitly disclose: *page make-up software application comprises QuarkXPress*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have included QuarkXPress, because Simpson teaches the automatic printing of personalized documents using a basic list of names and addresses which can be used over and over. Thus, providing the benefit of printing

personalized document as often as a user needs without ever retyping a single name or address

using an application such as *QuarkXPress*.

Regarding claim 5, which depends on claim 1, Simpson teaches using Wordperfect for

the creation of a primary merge file—*template*-- having commands telling Wordperfect exactly

where to place variable text extracted from the data found in the csv file—*first page description*

file-- (page 553, 855, fig. 25.3-4).

Regarding claim 6, which depends on claim 1, Simpson discloses using Wordperfect for

the conversion of the csv file—*first page description file*-- (fig.25.3) into a Wordperfect

formatted secondary merge file—*database*--, which contains a plurality of Wordperfect

formatted fields with the data found in the csv file—*characterizing each portion of the portions*

of the first page description file (fig.25.3-4, page 855).

Regarding claim 7, which depends on claim 1, Simpson discloses the conversion of a

plurality of data records, fields and respective format —*first data portion and second data*

portion-- from csv format to Wordperfect format, which contains the fields, and records

separated from each other within a file (page 855, fig.25.3-4).

Regarding claim 8, which depends on claim 7, Simpson discloses the storage of a csv file,

which contains data separated by commas and "CR/LF" commands—*content and control data*--

(page 855, fig.25.3).

Regarding claim 9, which depends on claim 8, Simpson discloses the conversion of a plurality of data records, fields and respective format from csv format to Wordperfect format using a "File Open" menu on a gui of the application (page 855, fig.25.3-4).

Regarding claim 11, which depends on claim 1, Simpson discloses the merging of two files, a primary merge file, such as form letters, mailing label, packing slip, etc.—*templates*-- A secondary merge file—*database*—containing records indicating information to be inserted into the primary merge files (page 540, lines 1-30, fig.25.3).

Regarding claim 12, which depends on claim 1, Simpson discloses the storage of a csv file —*image file*--, which contains data, such as "date, expense, amount..." —*image elements*-- which are displayed as font image on a computer screen separated by commas and "CR/LF" commands (page 855, fig.25.3).

Regarding claim 13, which depends on claim 12, Simpson teaches the merging of the primary merge file—*template*—and the Wordperfect formatted secondary merge file— *database*—(extracted from the csv file), to produce a third document —*second page description file* (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4).

Regarding claim 14, which depends on claim 1, Simpson teaches the merging of the primary merge file—*template*—and the Wordperfect formatted secondary merge file—

database—(extracted from the csv file), to produce a third document —*second page description file* (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4). In other words, the data in the secondary merge file is transferred to the primary merge file—*modifying the data stored in the database--* and then a third file is produced after the transfer. The data in the secondary merge file is no longer located just in the database.

Claim 15 is directed towards a software system for implementing the software found in claim 14, and therefore is similarly rejected.

Claims 16-21, 24-26 are directed towards a method for implementing the system found in claims 1, 3, 5-8, 11-12, and 14 respectively, and therefore are similarly rejected.

Claim 22 is directed towards a method for implementing the system found in claim 1, and therefore is similarly rejected.

6.   Claims 10, and 23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson, in view of Hohensee, further in view of Cohen, and further in view of Mastie (Pat. # 6,480,866, 11/12/02, filed on 6/30/98).

Regarding claim 10, which depends on claim 1, Simpson discloses the merging of two files, a primary merge file, such as form letters, mailing label, packing slip, etc.—*templates--* A secondary merge file containing records indicating information to be inserted into the primary

merge files (page 540, lines 1-30, fig.25.3). Cohen fails to explicitly disclose: *plurality of pages to be printed in a book.* However, Mastie teaches the printing of a plurality of pages in a book (c.4,L.14-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Simpson, and Mastie, because Mastie teaches above the creation of a book onto a single document which can be printed, stored, retrieved, etc.

Claim 23 is directed towards a method for implementing the system found in claim 10, and therefore is similarly rejected.

Response to Arguments

7.   Applicant's arguments filed 6/28/2004 have been fully considered but they are not persuasive. Regarding claims 1, and 16, the Applicants contend that that it is not appropriate to combine Simpson and Hohensee et al, to reject the claims at issue. A person of ordinary skill in the art would not have looked to the teachings of Hohensee et al. to modify Simpson, because Simpson relates to a system of merging a template with a database to create documents containing variable information, and Hohensee et al. relates to a file format conversion system for generating identical output pages. In addition, the merge feature of Simpson generates a variable page from a template and a database and is only responsive to a database that is entered by a user in comma- delimited text file format. Accordingly, the merge feature of Simpson is not responsive to files containing layout information; in particular, the secondary merge file of Simpson could not be generated from a file in PDF format (pages 3-4). The disagrees with this contention, because Simpson teaches the merging of the primary merge file—*template*—and the

Wordperfect formatted secondary merge file—*database*-- to produce a third document —*second*

page description file (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4). Simpson fails to

explicitly disclose: *Wherein the first page description file includes at least layout information for*

at least one page. However, Hohensee discloses extracting the body of a pdf file and placing it

in a database (col.10, lines 21-30). It would have been obvious to a person of ordinary skill in the

art at the time of the invention to have extracted text data of name, address, etc., records from a

pdf file, store the records in a database as ascii text by combining Simpson, and Hohensee,

because Hohensee teaches the benefit of avoiding redundant downloading of resources (col.3,

lines 1-15). This would allow a user to effectively, and efficiently utilize data records found in

pdf documents using the functionality of a wordprocessing program, such as Wordperfect.

Wordperfect also indicates the desirability to import data from other application programs so as

to enable the manipulation in Worperfect format (page 854).

Conclusion

8.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

I.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner

can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please

allow at least one business day.

Information regarding the status of an application may be obtained from the Patent

Application Retrieval (PAIR) system. Status information for published applications may be

obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, go to http://portal.uspto.gov/external/portal/pair. Should you have any questions about

access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866

217-9197 (toll-free).

    Any response to this Action should be mailed to:
                    Commissioner for Patents
                    P.O. Box 1450
            Alexandria, VA 22313-1450
        Or faxed to:
- **(571)-273-8300 (for all Formal communications intended for entry)**

CESAR PAULA
PRIMARY EXAMINER

4/14/06